

## REMARKS

### INTRODUCTION

In accordance with the foregoing, claim 9 has been amended. Claims 1-3 and 7-20 are pending and under consideration.

### ENTRY OF AMENDMENT UNDER 37 C.F.R. §1.116:

The Applicant requests entry of this Rule 116 Response because:

it is believed that the amendment of claim 9 places this application at least into a better form for purposes of appeal. No new matter is being added.

The Manual of Patent Examining Procedure sets forth in Section 714.12 that "any amendment that would place the case either in condition for allowance or in better form for appeal may be entered." Moreover, Section 714.13 sets forth that "the Proposed Amendment should be given sufficient consideration to determine whether the claims are in condition for allowance and/or whether the issues on appeal are simplified." The Manual of Patent Examining Procedures further articulates that the reason for any non-entry should be explained expressly in the Advisory Action.

### REJECTIONS UNDER 35 U.S.C. §103

Claims 1-3, 7, and 8 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 2,996,597 (Persinger et al.) in view of JP 11-201455 (hereinafter – JP '455). Persinger fails to teach or suggest, "...a heating unit installed in the cabinet at a position offset from an effective grill part of the grill unit" as recited in independent claim 1.

As shown in Fig. 1 of Persinger, the alleged heating unit 51 is *directly below* the alleged grill unit 28. Persinger states:

There is mounted an electrical heating unit 51 within the base 10 and **between the firebox 40 and the grill 28** for purposes of supplying heat either to a charcoal or other combustible fuel in the firebox 40 to aid in its ignition (*emphasis added*, col. 2, lines 31-38).

Thus, Persinger fails to teach or suggest, for example, "...a heating unit installed in the cabinet at a position offset from an effective grill part of the grill unit" as recited in independent claim 1.

The Office Action states:

“In regard to claim 7, when operated only with [the] electrical heating element, with no fuel present in [the] firebox tray 40, the tray inner wall surfaces (i.e. – flat bottom and inclined walls tray) would ***inherently*** collect droppings from the grill and reflect radiating heat energy, at least to some degree. Therefore, the tray is deemed the structural and functional equivalent to [the] Applicant’s broadly claimed removable ‘tray with a reflective plate.’”  
(See page 4 of the Office Action, *emphasis added*).

To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill in the art (see Continental Can Co. v Monsanto Co., 948 F.2d 1264, 20 USPQ2d 1746 (Fed. Cir. 1991)). The Examiner relies on personal knowledge and does not provide any extrinsic evidence that the claimed properties are inherently possessed in Persinger.

It appears that the Examiner bases his rejection on personal knowledge and fails to specifically point out in Persinger the alleged teachings of “a tray provided with a reflecting plate set at a predetermined position below the opening to collect a material dropping from the food laid on the grill unit.”

The Examiner is required under 37 C.F.R. § 1.104(d)(2) to support such an assertion with an affidavit when called for by the Applicant. Thus, the Applicant calls upon the Examiner to support such assertion with an affidavit.

On page 4, the Office Action asserts that JP ‘455 makes up for the deficiencies of Persinger.

The Office Action asserts that JP ‘455 teaches a cover member 12 extending from an edge of an opening to cover an upper surface of a heating blocking member 18 and downwardly inclined so that a material dropping from the food laid on the grill unit is guided into the opening.

Figs. 1 and 2 of JP ‘455 show the top-plate ring 12 extending **upwards**. Paragraph 9 of the translation of JP ‘455 states:

it is necessary to form a clearance between the top-plate ring 12 and the burner covering 18 but, and if a clearance is formed such, neither flame nor heat enters and is desirable in this clearance.  
See pg. 3, lines 2-3 of translation of JP ‘455.

The purpose of the top-plate ring 12 in JP ‘455 is to prevent *the heat and the flame* from the burner 20 from entering the area between the top-plate ring 12 and the burner covering 18. JP ‘455 is silent on “a cover member extending from an edge of the opening to cover an upper

surface of the heat blocking member and downwardly inclined so that a material dropping from the food laid on the grill unit is guided into the opening.” Thus, the obviousness rationale used in the Office Action to combine JP ‘455 with Persinger is insufficient.

The Office Action on page 4 states:

In regard to claims 1-3, 7, and 8, for the purpose of directing material dropping from the food laid on the grill unit into the opening, it would have been obvious to a person having ordinary skill in the art to modify the top of Persinger to include a downwardly inclined cover member extending from an edge of the opening to cover an upper surface of the heat blocking member, in view of the teaching of JP ‘455.

It is respectfully submitted that the Office Action's PTO obviousness response and continued reliance on rationale unsupported by the record is insufficient to meet the requirements under MPEP 707.07(f). Further, the purpose of the alleged cover member 12 in JP ‘455 is to form a clearance between the top-plate ring 12 and the burner covering 18, and if a clearance is formed, neither flame nor heat enters and is desirable in this clearance. See pg. 3, lines 2-3 of translation of JP ‘455. The Office Action merely issued an obviousness response including the Examiner's own conclusion (not supported in the record). Thus, this rejection rationale is improper. The relied upon motivation must be evidenced in the record.

Withdrawal of the rejection is respectfully requested.

Claims 1-3 and 7-20 are rejected under 35 U.S.C. §103(a) as being unpatentable over JP 299654 (hereinafter – Rinnai) in view of Persinger et al., JP 06-154100 (hereinafter – Matsushita), JP 2002-355178 (hereinafter – Hironobu), and JP ‘455.

For clarification purposes, the rejection of claims 1-3 and 7-20 should state: claims 1-3 and 7-20 are rejected under 35 U.S.C. §103(a) as being unpatentable over JP 299654 (hereinafter – Rinnai), JP 2002-355178 (hereinafter – Hironobu), and JP 06-154100 (hereinafter – Matsushita) in view of Persinger and further in view of JP ‘455.

On page 6, the Office Action admits that Rinnai does not show or disclose “a heat blocking member” or “a cover member...downwardly inclined,” *inter alia*.

On page 6, the Office Action relies on Persinger to cure the deficiencies of Rinnai.

On page 4, however, the Office Action states:

Persinger shows and discloses the invention substantially [as] set forth in the claims with [the] possible **exception** to: **a cover member** extending from an edge of the opening to cover an upper

surface of the heat blocking member and downwardly inclined so that a material dropping from the food laid on the grill unit is guided into the opening (*emphasis added*).

Thus, the Office Action admits that Persinger fails to teach or suggest “a cover member...downwardly inclined.”

Therefore, Persinger cannot be relied upon to cure the deficiencies of Rinnai.

In the last sentence of page 6 bridging page 7, the Office Action asserts that “it would have been obvious to a person having ordinary skill in the art to modify the heat unit of Rinnai to include a heat blocking member integrally extending from a reflecting member and to orient the heating unit in an upward direction toward the grill, in view of the teaching of Matsushita.”

As stated above, on page 6, the Office Action admits that Rinnai does not show or disclose “a heat blocking member” or “a cover member...downwardly inclined,” *inter alia*.

Matsushita does not teach or suggest “a heat blocking member integrally extending from a reflecting member.” Matsushita also does not teach or suggest “a cover member...downwardly inclined” and is not relied upon to do so.

The alleged heat blocking member of Matsushita is not “integrally extending from a reflecting member.” As shown in Fig. 1, the alleged heat blocking member 9 is not connected to and does not contact the alleged reflecting member of the heating unit 8. As shown in Figs. 2 and 3 of the present application, for example, the heat blocking member 60 integrally extends from the reflecting member 50. “Integrally” means to be “formed as a unit with another part” (see: Merriam-Webster Online Dictionary © 2006 by Merriam-Webster, Incorporated). A heat blocking member that is integrally formed to the reflecting member becomes a single unit because they are joined together.

The alleged heat blocking member 9 is formed “in the perimeter” of the alleged heating unit 8 (see: Para. 9 of translation of Matsushita and Fig. 1). Thus, Matsushita does not teach or suggest “a heat blocking member integrally extending from a reflecting member.”

On page 6, the Office Action relies on Hironobu to cure the deficiencies of Rinnai.

Nothing was cited or has been found in Hironobu suggesting modifications of Rinnai to overcome the deficiencies discussed above.

On page 6, the Office Action repeats its rejection of claims 1-3, 7, and 8 under 35 U.S.C. §103(a) as being made obvious by Persinger in view of JP '455 found on page 4. As stated above, JP '455 cannot be relied upon to make up for the deficiencies of Persinger.

Withdrawal of the rejection is requested.

#### IMPROPER OBVIOUSNESS RATIONALE

As noted above, the rejection rationale is that "it would have been obvious to a person having ordinary skill in the art to modify the top of Persinger to include a downwardly inclined cover member extending from an edge of the opening to cover an upper surface of the heat blocking member, in view of the teaching of JP '455."

Thus, the Office Action is setting forth a motivational rationale not supported by the record, but rather based solely on the Examiner's belief of what one skilled in the art may have tried or recognized.

However, to set forth a prima facie §103 rejection, there must be some evidenced reason for modifying a reference. Specifically, there must be evidence, outside of the present application, which motivates, leads, or suggests to one of ordinary skill to modify a reference. In addition, an "obvious to try" rationale for combining two references is not valid motivation under 35 USC §103. In re Goodwin, 576 F.2d 375, 377, 198 USPQ 1, 3 (CCPA 1978); In re Antonie, 559 F.2d 618, 195 USPQ 6 (CCPA 1977); In re Tomlinson, 363 F.2d 928, 150 USPQ 623 (CCPA 1966).

MPEP § 2142 states that "[w]hen the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the Examiner to explain why the combination of the teachings is proper."

The Examiner is required to present actual evidence and make particular findings related to the motivation to combine the teachings of the references. In re Kotzab, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); In re Dembiczak, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Broad conclusory statements regarding the teaching of multiple references, standing alone, are not "evidence." Dembiczak, 50 USPQ2d at 1617. "The factual inquiry whether to combine the references must be thorough and searching." In re Lee, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002) (citing McGinley v. Franklin Sports, Inc., 60 USPQ2d 1001, 1008 (Fed. Cir. 2001)). The factual inquiry must be based on objective evidence of record, and cannot be based on subjective belief and unknown authority. Id. at 1433-34. The Examiner must explain the reasons that one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious. In re Rouffet, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998).

Further, it is well settled that "the Board [and Examiner] cannot simply reach conclusions

based on [their] own understanding or experience - or on [their] assessment of what would be basic knowledge or common sense. Rather the Board [and Examiner] must point to some concrete evidence in the record in support of these findings." *In re Zurko*, 258 F. 3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). See also *In re Lee*, 277 F. 3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002), in which the court required evidence for the determination of unpatentability by clarifying that the principles of **"common knowledge" and "common sense"** may only be applied to the analysis of evidence, rather than be a substitute for evidence.

Thus, accordingly, a prima facie obviousness rejection requires evidenced motivation from something in the record that would lead one skilled in the art to combine the relevant teachings, again noting that the mere fact that the prior art may be modified in a particular manner does **not** make the modification obvious unless the prior art suggested the desirability of that modification.

Contrary to these requirements, the outstanding Office Action merely presents the proposal that the modification of Persinger to include the claimed downwardly inclined cover member, which the Office Action has interpreted as being disclosed in JP '455, and concludes the obviousness of the same, without providing support in the record for motivation of the same.

Such motivational conclusions are improper. The relied upon motivation must be evidenced in the record, and cannot be based merely on an opinion of the Examiner.

Accordingly, it is respectfully requested that the next Office Action following the above guidelines and present a new non-final Office Action, if necessary, presenting rejections based on the same.

## CONCLUSION

In accordance with the foregoing, the Applicant respectfully submits that all outstanding objections and rejections have been overcome and/or rendered moot, and further, that all pending claims patentably distinguish over the cited art. Thus, there being no further outstanding objections or rejections, the application is submitted as being in condition for allowance which action is earnestly solicited. At a minimum, the Board should enter this Amendment at least for purposes of Appeal as it either clarifies and/or narrows the issues for consideration.

If the Examiner has any remaining issues to be addressed, it is believed that prosecution can be expedited and possibly concluded by the Examiner contacting the undersigned attorney for a telephone interview to discuss any such remaining issues.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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